



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,865	09/05/2003	Alberto Silvestri	1006-002us	8102

7590 05/12/2005

SOFER & HAROUN, LLP
Suite 910
317 Madison Avenue
New York, NY 10017

EXAMINER

ABDELWAHED, ALI F

ART UNIT	PAPER NUMBER
----------	--------------

3722

DATE MAILED: 05/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/656,865

Applicant(s)

SILVESTRI, ALBERTO

Examiner

Ali Abdelwahed

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final:
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claim 19 is objected to because of the following informalities:

It is suggested that in:

Claim 19, line 2, delete "advertisement" and insert --advertisements--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 11-16 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S.

Patent No. 6,629,800 B1 to Brown.

Brown discloses an advertisement display (1) for placement within a printed publication (see figs. 3-6, and respective portions of the specification), the display comprising: a plurality of pages (6", 16) with at least one page having an image displayed thereon (see figs. 5, 6); and a plurality of panels (7-11, 16-19), each of the panels having at least one edge thereon (12-15, 20-23), wherein a first panel (19), among the plurality of panels and attached to the printed publication, is coupled to at

Art Unit: 3722

least one second panel (16) among the plurality of panels along at least one edge (22) of the first panel (see figs. 4, 6), such that the second panel is configured to be folded onto the first panel along the edge (see figs. 4, 6, and respective portions of the specification); wherein when the panels are folded over the image on the page, the image on the page is altered (see figs. 5, 6); a third panel (17) coupled to at least one edge (20) of the second panel (see figs. 4, 6), wherein the third panel is configured to be folded onto the second panel before the second panel is folded onto the first panel (see figs. 4, 6, and respective portions of the specification); a fourth panel (18) coupled to a second edge (23) of the first panel (see figs. 4, 6), wherein the fourth panel is configured to be folded onto the first panel before the second panel is folded onto the first panel (see figs. 4, 6, and respective portions of the specification); the coupling between the panels is formed along a solidly formed edge (see figs. 4, 6, and respective portions of the specification).

Claims 11-16 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,752,427 B1 to Wilen.

Wilen discloses an advertisement display (70) for placement within a printed publication (see columns 3 and 4, lines 36-38, 63-67 and 1-2, respectively), the display comprising: a plurality of pages (52); and a plurality of panels (see fig. 9), each of the panels having at least one edge thereon (see fig. 9), wherein a first panel (defined by the panel on the very left end of the top row E), among the plurality of panels and attached to the printed publication, is coupled to at least one second panel (defined by

the panel on the very left end of the middle row F, also the panel directly beneath the afore stated first panel) among the plurality of panels along at least one edge of the first panel (see fig. 9), such that the second panel is configured to be folded onto the first panel along the edge (see figs. 9-14); a third panel (defined by the panel second to the very left end of the middle row F, also the panel directly to the right of the afore stated second panel) coupled to at least one edge (77) of the second panel (see fig. 9), wherein the third panel is configured to be folded onto the second panel before the second panel is folded onto the first panel (see figs. 9-14); a fourth panel (defined by the panel second to the very left end of the top row E, also the panel directly to the right of the afore stated first panel) coupled to a second edge (15) of the first panel (see fig. 9), wherein the fourth panel is configured to be folded onto the first panel before the second panel is folded onto the first panel (see figs. 9-14); the coupling between the panels is formed along a solidly formed edge (see figs. 9-14, and respective portions of the specification).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilen in view of U.S. Patent No. 6,572,149 B2 to Long.

Wilén discloses the claimed invention except for the coupling between the panels being formed along a perforated edge; the panels contain individual advertisements designed to be removed independently from one another; and the individual advertisements are any one of coupons, business cards, product samples, a mailer for return mailing, and a list of store locations. However, Long teaches an advertisement display (10) comprising a coupling between the panels (11) being formed along a perforated edge (13); the panels contain individual advertisements designed to be removed independently from one another (see fig.1, and respective portions of the specification); and the individual advertisements are any one of coupons, business cards, product samples, a mailer for return mailing, and a list of store locations (see figs.1, 3, 4). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the advertisement display of Wilén, in view of Long, such that it would provide the advertisement display of Wilén with the concept of the aforementioned limitations for the purpose of enhancing the effectiveness of the advertisement display to provide the recipient with many more choices of advertisements to choose from.

Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of U.S. Patent No. 6,572,149 B2 to Long.

Brown discloses the claimed invention except for the coupling between the panels being formed along a perforated edge; the panels contain individual advertisements designed to be removed independently from one another; and the

Art Unit: 3722

individual advertisements are any one of coupons, business cards, product samples, a mailer for return mailing, and a list of store locations. However, Long teaches an advertisement display (10) comprising a coupling between the panels (11) being formed along a perforated edge (13); the panels contain individual advertisements designed to be removed independently from one another (see fig.1, and respective portions of the specification); and the individual advertisements are any one of coupons, business cards, product samples, a mailer for return mailing, and a list of store locations (see figs.1, 3, 4). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the advertisement display of Brown, in view of Long, such that it would provide the advertisement display of Brown with the concept of the aforementioned limitations for the purpose of enhancing the effectiveness of the advertisement display to provide the recipient with many more choices of advertisements to choose from.

Response to Arguments

Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ali Abdelwahed whose telephone number is (571) 272-4417. The examiner can normally be reached Monday through Friday from 10:00 A.M. to 6:30 P.M.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419.

Art Unit: 3722

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the examiner or the examiner's supervisor.

AA

05/05/2005



DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700